

REMARKS

The Examiner made Applicants' election with traverse final. The Examiner rejected Claims 6, 9, 10, 11, and 14 under 35 U.S.C. § 102(b) as being anticipated by Patent Number 5,608,196 (Hall). The Examiner rejected Claims 1, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over Patent Number 2,096,503 (Allread) in view of Hall. Such rejections are noted.

Applicants respectfully submit that Claims 1, 4-6, 9-11, and 14 are allowable for the following reasons.

Rejection Under 35 U.S.C. § 102(b)

Addressing the Examiner's rejection of Claims 6, 9, 10, 11, and 14 under 35 U.S.C. § 102(b), Applicant respectfully suggests that Hall does not anticipate the claims of the present invention. Section 2131 of the Manual of Patent Examining Procedure describes the basis for anticipation under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Claims 6, 9, and 10

With respect to Claim 6, the Examiner states that Hall discloses a low voltage terminal block by stating "a low voltage terminal block (28 for example)." Paper Number 20060728, Application Serial No. 10/760,615, at 3. The Examiner further states "said terminal block electrically connected to said module for communicating at least one low voltage control signal (see column 5 lines 5-8 for example)." *Id.*

Applicants point out that the component referred to by the Examiner, **28**, is illustrated in FIG. 2 of Hall, which Hall describes as a "dip switch **28**." Hall, Col. 5, lines 9-10. A dip switch is commonly known as a "dual in-line package" switch. Hall further states "This dip switch can be set to provide each individual dimmer switch **2**

with a unique address." Hall, Col. 5, lines 10-12. A close review of Hall does not show that the dip switch **28** is discussed further. Applicants respectfully submit that a dip switch is a different device than a terminal block, which is device for making terminations, that is, for connecting conductors to a circuit.

A close review of Hall, including a text word search, fails to show that Hall discloses a terminal block of any kind. Such a result is not surprising because the prior art uses conductor pigtails extending from such devices as disclosed in Hall. In fact, the Examiner alludes to these pigtails in the rejection with respect to the claimed terminal block. FIG. 2 of Hall discloses that "this dimmer switch also includes a low voltage connection using low voltage signal wires **14** to connect the dimmer switch to a lighting control system and to remote control units." Hall, Col 5, lines 6-9. The use of a terminal block to make connections instead of tying pigtails together is an advantage over the prior art. Applicants respectfully submit that Hall does not disclose a terminal block making electrical connections at any voltage level, particularly a low voltage terminal block as required by the claim.

Additionally, with respect to Claim 9, FIG. 2 of Hall shows the dip switch **28** that fits in a slot in the mounting flange plate **8**, and, as stated above, the dip switch **28** is not the same as, or equivalent to, a low voltage terminal block.

Applicants respectfully submit that Hall does not disclose each and every element of Claim 6, namely, Hall does not disclose a low voltage terminal block as required by the claim. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of Claim 11 because the claim is in condition for allowance. Further, Applicants respectfully submit that Claims 9 and 10 are also in condition for allowance as depending from an allowable base claim.

Claims 11 and 14

Claims 11 and 14 include means-plus-function limitations, as defined by 35 U.S.C. § 112, sixth paragraph. A means-plus-function limitation must be interpreted to cover the corresponding structure, materials, or acts in the specification and "equivalents thereof." 35 U.S.C. § 112, sixth paragraph; *see also* MPEP § 2181. The Examiner "must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, **in light of and consistent with the**

written description of the invention in the application." MPEP 2181, sub-section I, pg. 2100-220, 8th ed., rev. 2 (emphasis added).

In accordance with MPEP § 2181, it no longer is acceptable practice for the Examiner to interpret means-plus-function limitations "as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification." MPEP § 2181, pg. 2100-220 (emphasis added). The current practice is that "the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim." MPEP § 2182, pg. 2100-227. "However, if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function." *Id.* (emphasis added). The MPEP further states "The 'means or step plus function' limitation should be interpreted in a manner consistent with the specification disclosure." *Id.*

For making a *prima facie* case of equivalence for a means-plus-function limitation, the MPEP states

If the examiner finds that a prior art element

- (A) performs the function specified in the claim,
- (B) is not excluded by any explicit definition provided in the specification for an equivalent, and
- (C) is an equivalent of the means-(or step-) plus-function limitation,

the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent.

MPEP § 2183, pg. 2100-228. With respect to the third element above, the prior art element is an equivalent, the MPEP states that a factor supporting such a conclusion is "(D) the prior art element is a structural equivalent of the corresponding element disclosed in the specification." MPEP § 2183, pg. 2100-228. The MPEP further requires that "the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding

element described in the specification." MPEP § 2183, pg. 2100-228 (emphasis added).

Accordingly, it is necessary to consider the specification in determining the scope of the rejected claims.

Claim 11 includes limitations for "a means for terminating a plurality of low voltage conductors to said controller." Applicants' specification states: "The function of terminating a plurality of low voltage conductors **314** to the controller **202** is implemented, in one embodiment, by the screw terminals **312**, and in other embodiments, by the terminal blocks **604, 704.**" Specification, pg. 3, para. 37. Applicants respectfully submit that Claim 11 is not anticipated by Hall because Hall does not disclose any equivalent structures corresponding to those disclosed in Applicants' specification, and, therefore, Hall does not teach every element of the claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw his rejection of Claim 11 because the claim is in condition for allowance.

Further, notwithstanding that Claim 14 is also in condition for allowance as depending from an allowable base claim, Claim 14 is allowable because the above described means (a terminal block) do not protrude from an opening in a face plate.

Obviousness Under 35 U.S.C. § 103

The Examiner rejected Claims 1, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over Allread in view of Hall. A rejection under 35 U.S.C. § 103(a) must be supported by a *prima facie* case of obviousness. MPEP § 2142. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142, pg. 2100-121.

The first element in establishing a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." MPEP § 2143. The second element is that there must be a reasonable expectation of success. *Id.* The third element is that "the prior

art reference (or references when combined) must teach or suggest all the claim limitations." *Id.* "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper); *see* MPEP § 2143.01.

Claims 1, 4, and 5

With respect to Claim 1, the Examiner states that Hall discloses a low voltage terminal block by stating "a low voltage terminal block (28 for example)." Paper Number 20060728, Application Serial No. 10/760,615, at 6. As stated above, Hall does not disclose a terminal block and item **28** is a dip switch, which is not the same as, or an equivalent of, a terminal block.

Applicants respectfully submit that Hall does not disclose each and every element of Claim 1, namely, Hall does not disclose a low voltage terminal block as required by the claim. The prior art discloses joining a pair of pigtails to make an electrical connection. Using terminal blocks for low voltage connections provides connections that are more secure, easily verifiable, and easily removable compared to joining pigtails. Applicants respectfully submit that the Examiner has not satisfied the third element of *prima facie* case of obviousness, that the references disclose all the claimed elements. Accordingly, Applicants submit that Claim 1 is in a condition for allowance, and that Claim 1 is in condition for allowance. Further, Applicants respectfully submit that Claims 4 and 5 are in condition for allowance as depending from an allowable base claim.

Notwithstanding that Claims 1, 4, and 5 are allowable for the above reasons, Applicants respectfully disagree with the characterization of Allread made by the Examiner. The Examiner states that "Allread substantially discloses an apparatus for a residential low voltage control system operated by a door." Paper Number 20060728, Application Serial No. 10/760,615, at 5. Applicants respectfully disagree that Allard discloses an apparatus for a residential low voltage system, as described by

Applicants in their specification. Allread does not disclose a system in which two different levels of voltage are present, a high voltage for the power conductors to the controlled device and a low voltage for the connection to the switch. Allread is representative of the prior art described by the Applicants that existed before automation began to replace such systems as disclosed in Allread. See, Specification, pg. 1, para. 06.

Conclusion

In view of the above, which shows that Hall does not disclose a low voltage terminal block as required by the claims, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the Examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 50-3827 (05017-UPA).

Respectfully submitted,



Thomas A. Kulaga
Registration No. 46,844

Knox Patents: Kulaga Law Office, PLLC
P.O. Box 30034
Knoxville, Tennessee 37930-0034
865-470-4212 (voice)
tkulaga@knoxpatents.com